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MARK P. BOURGEOIS P.O. BOX 95 OSCEOLA, IN 46561			PARA, ANNETTE H	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/944, 932  
Filing Date: August 24, 2001  
Appellant(s): Notcutts Limited

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Mark P. Bourgeois  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 26, 2006 appealing from the Office action mailed February 24, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The Examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be reviewed on Appeal**

The Appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

United Kingdom Plant Breeder's grant number 03000204.

New Royal Horticultural Society Dictionary of Gardening on page 245, for information on how to propagate Euphorbia plant.

Appellant's response to the request for information under 37 CFR 1.105 regarding the sale or distribution of the plant anywhere in the world prior to the filing date and if the sale was an obscure solitary occurrence.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right grant number 03000204 in the United Kingdom, in view of applicant's admission that 'Charam' was sold in The United Kingdom as early as April 1 1998 (page 3 of reply filed October 18, 2002). The application requires information pertaining to any prior sale. This document is open to public inspection. This is also evidenced in the UPOV-ROM GTITM Computer Database citation under the heading "DATE PUBL.GRANT/REG". Additionally, the Appellant, Breeder and Assignee are all listed on this publication. As a result, one of ordinary skill in the art would have known whom to contact to purchase the plant.

The grant was published on January 1, 1998, more than one year prior to filing of the instant application. The grant is a "printed publication" under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See MPEP § 2128. The Community Plant Variety Office publishes applications for variety protection. Once the Breeder's Grant is made, the variety and description are entered in the Plant Variety Protection Register. The register, grant and published applications are accessible to the public. This information was available on-line as well as in CD-Rom format as of the date listed that the grant/filing was published which in this case was January 1, 1998 and

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is more than one year prior to filing of the patent application in the United States. Thus, information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) (“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

While the publication cited above discloses the claimed plant variety, a question remains as to whether the references are enabling. Public availability of the plant, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the claimed plant. Appellant has admitted that the claimed plant was for sale more than one year prior to application for U.S. patent and thus was in the public domain. *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004) states “When a publication identifies the plant that is invented or discovered and a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar” (1041) and “the foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. Its availability must have been known in the art, just as a printed publication must be publicly available” (1043). Appellant’s admission that ‘Charam’ was sold in the United Kingdom in April 1, 1998 does not appear to be an obscure or isolated occurrence. The UPOV-ROM GTITM Computer database list the breeder and assignee name. The breeder is in the business of selling plants. One of the ordinary skill in the art could have called

the breeder and asked for Charam cultivar. The breeder would have sold the plant explaining that this cultivar was sold under a different name. The fact that Appellant admits to selling the plant sustains this scenario. The reproduction of *Euphorbia* spp. is clearly explained in the New Royal Horticultural Society Dictionary of Gardening on page 245. As a result, one of ordinary skill in the art could have bought the plant and asexually propagated it, thus reproducing the invention without undue experimentation. Therefore, the claim is anticipated by the published Plant Breeder's Right Grant.

#### **(10) Response to Argument**

**Appellant argues** (page 10 of brief) that if documents were not readily obtainable by the U.S. Patent Office that has access to a vast array of resources, why would they be available to an isolated plant breeder.

This is not found persuasive because the Plant Breeder's Right documents, besides being referenced on the Internet, are available to the public at the Community Plant Variety Office. Thus the "degree of availability" is analogous to the fact situation in *In re Wyer*, where patent documents were available at a foreign patent office.

**Appellant argues** (page 10 of brief) that the public use and availability of the subject plant variety outside of the United States is not material to a determination of "plant patentability" of a plant variety in the United States under 102(b).

This argument is not persuasive however because, the rejection is based on a printed publication, not public use/on sale. The printed publication bar applies no matter where the publication was made. Public availability of the plant shows that the publication was "enabled".

Appellant's argument is not persuasive to patentability, as there is no geographic component of enablement. For example, for a patent specification to be enabling, there is no requirement that the starting material required to produce the claimed invention must be located in the United States. See *Ex parte Rinehart*, 10 USPQ2d, 1719, (Bd. Pat. App. & Inter. 1989). A printed publication identifying the breeder and assignee of a particular plant in combination with the public availability of the plant places the plant in the public

possession. Response in paper number 3, page 3, Appellant admits that “the first sale date was in the United Kingdom in April 1, 1998.” *In re Elsner* “the foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. Its availability must have been known in the art, just as a printed publication must be publicly available” (1043). The UPOV-ROM GTITM Computer database lists the breeder and assignee name. The breeder is in the business of selling plants. One of ordinary skill in the art could have called the breeder and asked for Charam cultivar. The breeder would have sold the plant explaining that this cultivar was sold under a different name. The fact that applicant admits to selling the plants sustains this scenario. It is clear that the sale was not an obscure, solitary occurrence that would go unnoticed by those skilled in the art.

**Appellant argues** (pages 10-11 of brief) that neither a non-enabling printed publication by itself nor foreign public use can be cited as prior art under 102(b) and *Ex parte Thomson* combined two non-prior art references.

Appellant’s arguments are not persuasive, as the propriety of this type of rejection was recently affirmed by the Court of Appeals for the Federal Circuit. *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004) states, “However, because the public may have had access to the claimed inventions through the foreign sales of the plants, from which the claimed plants may be reproduced, it may fairly be said that the PBR applications are adequately enabled. Because the published applications, combined with the foreign sales of the plants, placed the claimed inventions in the possession of the public, we therefore hold that they are proper 102(b) anticipatory references that may bar patentability” (page 1042). As stated above, Appellant admits that the sale of the claimed cultivar occurred in the United Kingdom in April 1, 1998, more than one year before the filing date of the instant application. *Elsner* also states, “Only when possession derived in this manner enables a person of skill in the art to practice asexual reproduction of the plant in a manner consistent with the statute can a non-enabling publication and foreign sales act as a 102(b) bar” (page 1041). “The foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art” (page 1043). Therefore, the published

PBR application and the accessibility of the foreign sale of the claimed plant, and the knowledge of reproducing a euphorbia plant as described on the new Royal Horticultural Society Dictionary of Gardening on page 245, would elicit a rejection under 35 U.S.C. 102(b).

**Appellant argues** (page 11 of brief) that it is improper to rely on a combination of references to anticipate the claimed invention under 35 U.S.C. 102(b).

This argument is not found persuasive because the admission of Appellant that the plant was for sale more than one year prior to application for U.S. patent is not “supplementing” the primary reference, rather the sale of the plant provides proof that the primary reference was enabling. The Examiner would like to point out how the two cited cases support the rejection that was made under 102(b). As noted in *In re Samour*,

“a printed publication which discloses every material element of the claimed subject matter, would constitute a bar under 35 USC 102(b) to appellant's right to a patent if, more than one year prior to appellant's filing date, it placed [the claimed subject matter] ‘in possession of the public.’ Whether claimed subject matter was in possession of the public depends on whether a method of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the pertinent art.” 197 USPQ at 3-4 (citations omitted).

The court noted that a printed publication that places the invention in possession of the public would constitute a bar under 35 USC 102(b). This language is also used in *LeGrice* as is discussed in further detail below. A printed publication identifying the breeder and assignee of a particular plant in combination with the public availability of the plant places the plant in the public possession.

The court further noted that the disclosure in the primary reference must be considered together with the knowledge of one of ordinary skill in the pertinent art, and that it is appropriate to rely on additional references solely as evidence that, more than one year prior to appellant's filing date, a method of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the art. 197 USPQ at 4.

**Appellant argues** (page 12 of brief) that for the American public to get access use and duplicate a plant variety, propagatable plant material from the plant in question



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must be available in the United States. Without access to the plant material, the plant cannot be reproduced. The Plant Quarantine Act of 1912 controls the importation of nursery stock into the United States.

This is not found persuasive because Appellant is reminded that the rejection is over a publication. Additionally, the customs and quarantine importation procedures have nothing to do to enable a publication.

**Appellant argues** (page 12 of brief) that *In re LeGrice* case was concerned with whether foreign plant varieties are actually available to the American public.

This is incorrect as *LeGrice* was concerned with whether printed publications must be enabled to anticipate a claimed invention. In *LeGrice* there is no requirement for access to the plant by Americans. Also, Americans could have purchased the plant and imported it (through quarantine). Biological material is considered available even if it must pass through quarantine. See MPEP 2404.01 (last paragraph). The question in *LeGrice* was whether publications must be enabling to support a rejection under 102(b). The answer was yes, the invention must be in possession of the public. Public use or sale can put the invention in the public domain. Once the claimed plant is in the public domain, printed publications are enabled because one can readily obtain the starting materials necessary to make the invention, as set forth in the *Thomson* decision.

**Appellant argues** (pages 13-14 of brief) that it is doubtful that one skilled in the art who is interested in reproducing *Euphorbia Charam* would know to go to the United Kingdom and purchase plants under the different name of *Redwing* in order to replicate the plant.

This argument has been carefully considered but is not persuasive. If applicant only had to change a name of an invention to be able to bypass a 102(b) rejection then it would completely undermine Congress's intent that speedy application for US patent should occur. In this case Appellant waited 3 years before filing within the U.S. which is not the intent of 35 U.S.C. 102 that states that applications should be filed within one year of filing in other countries. Does a name change obscure the issue that one of skill in the art would have been able to purchase the plant? Does a name change obscure the issue that

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the sale was not a single, isolated, occurrence? Does a name change mean that one of the ordinary skill in the art would not have been able to propagate the plant? The Examiner believes that this is not the case for each of the posed interrogatories and the name of the plant is irrelevant. The "how to make" and "use" requirement has been met. One of the ordinary skill in the art would have been able to obtain the plant and make/use the plant based on the previous cited evidence, thus enabling the publication. If all Applicants need do, is change the name of the plant, then conceivably any plant from overseas could be sold here under a different name and not infringe any intellectual property rights. Moreover, the UPOV-ROM GTITM Computer database lists the breeder and assignee name. For applicant to state that one of the ordinary skill in the art would be unable to purchase the plant under a different name and not know it was the same plant is not a valid argument. One cannot overlook the fact that when contacted by one of the ordinary skill in the art, the breeder, eager to sell, would indicate to the former that the plant is available and sold under another name. It is clear that a difference in names does not obscure the fact that one of ordinary skill in the art could have bought the plant, as the sale was not a single, isolated occurrence, and could have reproduced the plant since asexual reproduction of euphorbia is well documented in the art, thus enabling the Plant Breeder's Right grant.

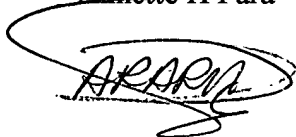
**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Annette H Para

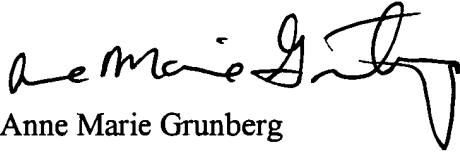


Conferees:

Bruce Campell

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SPE, AU 1648



Anne Marie Grunberg

SPE, AU 1638 and 1661



BRUCE CAMPBELL, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600